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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,204	08/10/2001	Martin Foltin	10011094-1	3853

22879 7590 05/13/2005

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

STEVENS, THOMAS H

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,204

Applicant(s)

FOLTIN ET AL.

Examiner

Thomas H. Stevens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 were previously presented.
2. Claims 8 and 10 are cancelled.
3. Claims 1-7,9, 11-20 were presented and examined.

Interview Summary

4. Examiner and attorney (Kelly Lee) were divergent on 5/5/05 why the present application (claim 1) is a broader teaching of an echo-circuit relative to claim 1 of U.S. Patent 6,581,197 (2003)). The office asserts claim 1 of the application teaches a broader limitation of echo signals and their timing paths. Although both the claimed invention and issued patent teach creating echo signals of a plurality of parameters {application: lines 5-15; patent: column 12, lines 43-52} the broader description {application} teaches "identifying and comparing relevant timing paths in the echo-circuit... associated with the plurality of parameters" (amended claim 1, lines 13-18), while the patent is specific regarding finding (extracting) a valid time parameter (Patent: column 12, lines 35-42). Thus the allowance is withdrawn to be replaced with obvious and statutory double patenting rejections.

Section I: Response to Applicant's Arguments

5. Examiner acknowledges and agrees with applicant's response regarding the claim interpretation.
6. Applicants are thanked for addressing this issue. In light of amended claims, the prior rejection under 35 U.S.C 103 is withdrawn.

Section II: Non-Final Office Action (2nd office action)

Allowable Subject Matter

6. Claims 1-7,9, 11-20 would be allowable as long as applicant overcomes the double patenting rejection since the prior art of record doesn't expressly teach or render obvious the claimed invention as recited in independent claims 1, 11 and 14. coupled with the dependent claims ties the claims as a whole. Specifically, the invention defines an echo signal (as described within the specification pg. 26, lines 7-11) is a stimulus independent port-based that has no internal latch nodes, and is used for any static timing analysis (STA), wherein the echo-circuit includes a dummy latch node that is controlled by an internally generated clock signal that becomes active when a latest clock signal from the circuit arrives.

Though the prior art of record expressly teaches subsequent functions of using dummy latches and sensitive latches to propagate a transition of integrated circuits is divorced from the teachings recited from independent claims 1,11 and 14. However, as provided below, obviousness double patenting is asserted, based on the aforementioned motivation statements held within the obviousness double patenting with regard to U.S. patent 6,581,197.

Statutory Double-Patenting Rejection

7. Claim 1 of U.S. patent 6,581,197 contains every element of claim 1 of the instant application and such anticipates claim 1 of instant application. Both teach creating echo

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signals of a plurality of parameters (application: lines 5-15; patent: column 12, lines 43-52); however, the application teaches "identifying and comparing relevant timing paths in the echo-circuit... associated with the plurality of parameters" (amended claim 1, lines 13-18), whereas the patent is specific regarding finding (extracting) a valid time parameter (Patent: column 12, lines 35-42).

"A latter patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2 at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). *ELI LILLY AND COMPANY V BARR LABORATORIES, INCL.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Terminal disclaimers is not effective in overcoming a statutory double patenting rejection. The use of a 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate. (MPEP 804.02)

Obviousness Double-Patenting Rejection

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,581,197. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach creating echo signals of a plurality of parameters (application: lines 5-15; patent: column 12, lines 43-52), while the application teaches "identifying and comparing relevant timing paths in the echo-circuit...associated with the plurality of parameters" (amended claim 1, lines 13-18), whereas the patent is specific regarding finding (extracting) a valid time parameter (Patent: column 12, lines 35-42).

At the time of invention it would have been obvious to one of ordinary skill in the art to detail the comparing process by extracting a valid timing parameter to in order to trace the latest clock signals. Summarily, both the application and the patent teach a dummy latch node which is controlled by an internally generated clock signal that becomes active when the latest clock signal from the circuit path arrives at the output port (Patent: column 12, lines 39-42; amended application claim 1: lines 8-10). This is obviousness double patenting.

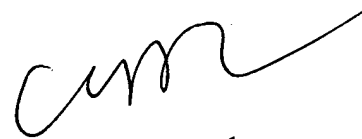
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is 571-272-3715, Monday-Friday (8:00 am- 4:30 pm) or contact Supervisor Mr. Kevin Teska at (571) 272-3716. Fax number is 571-273-3715.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

May 11, 2005

THS


W. Thomas
Revised
Art 2123
TC 2100
5-11-05